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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/766,941      | 01/30/2004  | Dietmar Janz         | P24819              | 4403             |

7055 7590 11/02/2005

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| EXAMINER |
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LAMB, BRENDA A

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| ART UNIT | PAPER NUMBER |
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1734

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/766,941

Applicant(s)

JANZ ET AL.

Examiner

Brenda A. Lamb

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 05 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,10 and 12-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 14-15 is/are allowed.
- 6) ☒ Claim(s) 1-7,9,10,12,16-25,28 and 29 is/are rejected.
- 7) ☒ Claim(s) 13,26,27 and 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/05/2005
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-2, 4-6, 9-10, 12, 16, 17, 20-25 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 89/04727.

WO '727 teaches a method and system for applying glue or adhesive material to a moving work or web, the system comprising: a glue nozzle coupled to glue reservoir; the glue nozzle comprising a tip or pointed end portion which tapers to the outlet opening which is arranged to apply glue to the moving web while the moving web

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moves along a direction, and a device, tube 13 having a tip arranged adjacent or near the tip, that delivers a substance to a region or area surrounding and behind the outlet opening. WO '727 teaches applying the glue onto the moving work or web while the moving web moves along a direction and shows in Figure 7 feeding the solvent to a device arranged both behind the outlet opening and thereby reads on claim limitation that the device delivers the substance behind the outlet opening relative to the direction. Thus WO '727 teaches every structural element of the system set forth in claim 1 and every method step set forth in claim 16. With respect to claim 2, WO '727 apparatus is capable of applying glue or adhesive material onto a web which is one of a cigarette paper web in strip form and folding box blanks since it teaches every claimed structural element of the claimed apparatus. With respect to claim 4, WO '727 system is capable of delivering a substance adapted to liquefy the glue, a low-viscosity fluid, water, and water vapor. With respect to claim 5, WO '727 teaches the device delivers the substance directly behind the outlet opening the relative to the direction as shown in Figures 14 and 22. With respect to claim 17, WO '727 process delivers a substance adapted to liquefy the glue, a low-viscosity fluid or solvent. With respect to claim 9, WO '727 shows in Figures 14 and 22 the device is arranged at a distance "d" from the glue nozzle. With respect to claims 10-11, WO '727 shows in his Figures that a device directly adjacent to the tip portion of the glue nozzle. With respect to claims 6, 10, 12-13, 20-25 and 29, WO '727 teaches a system for regulating the feeding of the substance to the device and controls feeding in the manner set forth in claims 6 and 20-

25 dependent on whether or not is applying a pattern to the substrate and the type of pattern applied to the substrate.

Claims 7 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 89/04727.

WO '727 is applied for the reasons noted above. WO '727 fails to teach liquefying the glue after applying the glue to the web. However, it would have been obvious the WO '727 process is liquefied after applying the glue to the web due the proximity of the solvent applying means to the substrate as shown in the WO '727 Figures. With respect to claim 7, although WO '727 fails to teach the tube is a capillary tube or a tube having a very small bore, it would have been obvious to use as tube for delivering solvent adjacent or not distant to the tip portion of the glue nozzle in the WO '727 process and apparatus one having a small diameter or bore such as a capillary for the obvious advantage to enable one to precisely deliver minute amounts of solvent to the above cited tip portion. With respect to claim 28, WO '727 teaches

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 89/04727 in view of Fietkau.

WO '727 is applied for the reasons noted above. Although WO '727 fails to teach his apparatus is arranged on a cigarette making machine it would have been obvious to do so since glue applicator are known to be arranged on cigarette making machine as shown Fietkau.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 89/04727 in view of Yapel et al.

WO '727 is applied for the reasons noted. WO '727 fails to teach conveying after the feeding the moving web away the device. However, it would have been obvious to modify the WO '727 method and apparatus by moving the substrate using a conveying means after the feeding such that the substrate or web moves away from the device since Yapel et al teaches conveying, using a conveying means, the substrate past the applicator which includes a device for feeding a substance which liquefies the glue and which is arranged behind the outlet for the obvious advantage in simplicity in design of moving the substrate relative to the applicator rather than the moving the applicator relative to the substrate and especially since WO '727 appears to teach the conveying of the substrate relative to the glue nozzle and device.

Applicant's arguments filed 8/05/2005 have been fully considered but they are not persuasive.

Applicant's argument that the opening adjacent the nozzle tip in WO '727 is not tube 13 and is not separate from the glue nozzle is found to be non-persuasive. First of all, it is noted that method claims do not require the claimed device to be separate from the glue nozzle rather only require that the claimed device is a tube whose tip is arranged adjacent the tip of the glue nozzle. Second of all, the tip or pointed end of the glue nozzle is that portion of the glue nozzle which tapers in width with respect to the outer diameter (like applicant's tip 20 which tapers conically towards free end 18 – see paragraph 0029 of the instant specification). Therefore, the recitation that the tip of claimed device is adjacent, which can be broadly read as “not distant” according to Meriam-Webster's Collegiate Dictionary (Tenth Edition), to the tip of the glue nozzle

does not define applicant's invention over WO '727 in that the tip of tube 13 as shown in Figure 7 is arranged adjacent or not distance from the tip portion of the glue nozzle which is comprised of walls which taper in outer diameter toward the free end or outlet orifice.

Claims 13, 26-27 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 14-15 are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

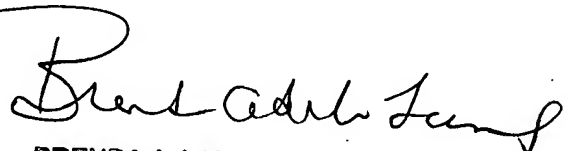
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Lamb whose telephone number is (571) 272-

1231. The examiner can normally be reached on Monday and Wednesday thru Friday with alternate Tuesdays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**BRENDA A. LAMB**  
**PRIMARY EXAMINER**